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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,202	06/23/2005	Masao Mori	123647	9024

25944 7590 04/23/2007  
OLIFF & BERRIDGE, PLC  
P.O. BOX 19928  
ALEXANDRIA, VA 22320

EXAMINER

CUTLIFF, YATE KAI RENE

ART UNIT	PAPER NUMBER
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1609

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	04/23/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

### Application No.

10/533,202

### Applicant(s)

MORI ET AL.

### Examiner

Yate K. Cutliff

### Art Unit

1609

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on 23 February 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,8,10 and 11 is/are rejected.
- 7) ☒ Claim(s) 2,5-7,9 and 12-14 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 08/15/006 **4728105**
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election with traverse of Group I, claims 1-7 in part and claims 8-14 in part in the reply filed on February 23, 2007 is acknowledged. The traversal is on the ground that claims 1-14 are sufficiently related such that a thorough search and examination can be conducted without serious burden. This was persuasive because under MPEP § 803.

The restriction requirement as set for the in the Office Action mailed on February 8, 2007 is has been reconsidered in view of applicants arguments. The restriction requirement is withdrawn and claims 1-14 in total were considered in the following examination.

In view of the above noted withdrawal of the restriction requirement, applicant is advised that if any claim presented in a continuation or divisional application is anticipated by, or includes all the limitations of, a claim that is allowable in the present application, such claim may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application.

Once a restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

Therefore, claims 1-14 are under consideration and currently pending.

***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

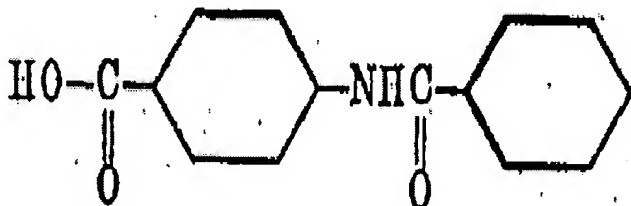
A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1 and 8 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Abraham et al. (U.S. Patent 3,175,950).

Abraham et al. discloses a species that is fully embraced by the claimed genus.

Abraham et al. discloses the following compound.



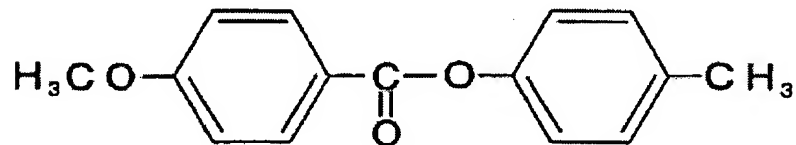
The structure as shown appears to have two cyclohexane rings; however, Abraham et al. defines the rings as two benzene rings. Specifically, the compound above, according to Abraham et al., includes the principal chromophoric group a benzanilide nucleus. (See column 1, lines 45 – 49). The base structure for a benzanilide is known in the art as having two phenyl groups as exemplified by attachment A-1.

The compound as shown in column 3 at lines 48- 50 of Abraham et al., anticipates claims 1 and 8 when X represents NH, Z represents a phenyl group substituted by a carboxyl group, and Y represents a phenyl group.

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4. Claim 8 rejected under 35 U.S.C. 102(b) as being clearly anticipated by Baudet (WO 92/19223).

Baudet. discloses a species that is fully embraced by the claimed genus. Baudet discloses the following compound of formula IV in their claim 4.



The above compound anticipates claim 8 when X represent O, Z represents a phenyl group substituted by a carboxyl group, and Y' represents a phenyl group substituted by a methoxy group.

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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7. Claims 1, 3, 4, 8 10 and 11 rejected under 35 U.S.C. 103(a) as being unpatentable over Sabatelli (U.S. Patent 4,937,370) in view of Baudet (WO 92/19223) See PTO-1449, Cite No. 1, received June 28, 2005.

Sabatelli teaches a sunscreen compound of the basic formula:



The description of the genus, as set out in column 4 lines 6-19 and lines 40-68, and columns 5 and 6 of the Sabatelli specification.

Baudet's claim 4 discloses a N-phenyl-cinnaamide of formula IV, see 102(b) above.

The description of the genus of Sabatelli is broader than the instant claims. However, Baudet is a subgenus within the genus of Sabatelli and substantially similar to the compounds of claims 1 3, 4, 8, 10 and 11 as disclosed by the instant invention. The only difference between the compound of Baudet's claim 4 and those of Applicant's claims 3, 4, 10, and 11 is the location of the "methoxy" when Y or Y' is a phenyl; and the location of the methyl when Z is a phenyl. Since the compound of Baudet's claim 4 is used as UV protection, it would be prima facie obvious to move the substituents around the phenyl ring as Applicant has done in the compounds of claims 1, 3, 4, 8, 10, and 11, under the contemplation that the same positive results would be achieved because of very close structural similarities. Thus it would have been obvious to one having ordinary skill in the art at the time that Applicant's invention was made to expect that the compounds of claims 3, 4, 10 and 11 would function in an equivalent manner to Baudet and the genus of Sabatelli.

***Allowable Subject Matter***

8. Claims 2, 5, 6, 7, 9, and 12 - 14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: None of the references teach a compound or suggest a compound for protection against ultraviolet rays as described in Claims 2, 5, 6, 7, 9, and 12 - 14.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yate K. Cutliff whose telephone number is (571) 272-9067. The examiner can normally be reached on M-TH 8:30 a.m. - 4:30 p.m..


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tssang can be reached on (571) 272 - 0562, or Janet Andres at (571) 272 - 0867. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Additional references are listed on PTO Form 892 that are considered to be relevant to the state of the art but which were not cited in this office action.

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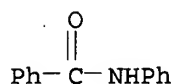
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Yaté K. Cutliff  
Patent Examiner  
Art Unit 1609, Group  
Technology Center 1600



**VICKIE KIM**  
**PRIMARY EXAMINER**

L16 ANSWER 1 OF 1 REGISTRY COPYRIGHT 2007 ACS on STN  
RN 93-98-1 REGISTRY  
ED Entered STN: 16 Nov 1984  
CN Benzamide, N-phenyl- (CA INDEX NAME)  
OTHER CA INDEX NAMES:  
CN Benzanilide (8CI)  
OTHER NAMES:  
CN Benzoic acid anilide  
CN N-Benzoylaniline  
CN N-Phenylbenzamide  
CN N-Phenylbenzenecarboxamide  
CN NSC 3131  
DR 100747-15-7  
MF C13 H11 N O  
CI COM  
LC STN Files: AGRICOLA, ANABSTR, AQUIRE, BEILSTEIN\*, BIOSIS, CA, CAOLD,  
CAPLUS, CASREACT, CHEMCATS, CHEMINFORMRX, CHEMLIST, CIN, CSCHEM,  
DETERM\*, EMBASE, GMELIN\*, IFICDB, IFIPAT, IFIUDB, MEDLINE, MRCK\*,  
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(\*File contains numerically searchable property data)  
Other Sources: DSL\*\*, EINECS\*\*, TSCA\*\*  
(\*\*Enter CHEMLIST File for up-to-date regulatory information)



\*\*PROPERTY DATA AVAILABLE IN THE 'PROP' FORMAT\*\*

1677 REFERENCES IN FILE CA (1907 TO DATE)  
61 REFERENCES TO NON-SPECIFIC DERIVATIVES IN FILE CA  
1681 REFERENCES IN FILE CAPLUS (1907 TO DATE)  
1 REFERENCES IN FILE CAOLD (PRIOR TO 1967)